

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

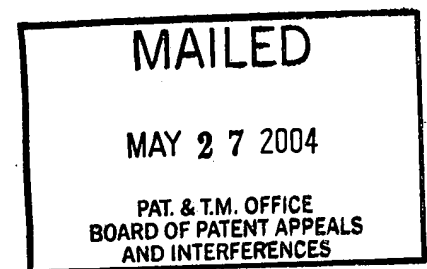
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

**Ex parte** JAMES ZEANAH, CHARLES ABBOTT, NIK BOYD, ALBERT COHEN,  
JAMES COOK, MICHAEL GRANDCOLAS, SIKUN LAN, BONNIE LINDSLEY,  
GRIGOR MARKARIAN and LESLIE MOSS

Appeal No. 2003-0613  
Application No. 09/323,210

ON BRIEF



FLEMING, RUGGIERO, and MACDONALD, **Administrative Patent Judges.**  
MACDONALD, **Administrative Patent Judge.**

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 58-111.

**Invention**

Appellants' invention relates to a system and method for delivering financial services to a remote device (See Appellants' specification at page 5, lines 18-19). A mini app (mini application or applet) dialog software program collects information needed to perform a function requested by the remote

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device and instantiates (creates) a transaction executor software program to carry out the function (See Appellants' specification at page 5). The system includes a presentation manager, which maps messages from a canonical (standard) format into the desired format for a particular remote device (See Appellants' specification at page 6, lines 2-5). The presentation manager also receives incoming messages from the remote device and converts information from the device specific format into a tagged canonical representation (See Appellants' specification at page 12, lines 12-14).

Claims 58 and 72 are representative of the claimed invention and are reproduced as follows:

58. A system for delivering services from a host site to a remote device, comprising:

a mini-app dialog component for receiving a request for a service function from the remote device; and

a transaction executor component instantiated by the mini-app dialog component to perform the requested service function.

72. A method for delivering services from a host site to one or more users through one or more remote devices, comprising:

receiving a first request for a service function from a first user through a first remote device, wherein the first request for a service function is in a first format designated for a first remote device;

converting the first request for a service function from the first format into a canonical format;

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performing the first requested service function based on the canonical format of the first request for a service function.

### References

The references relied on by the Examiner are as follows:

Hilt et al. (Hilt)	5,465,206	Nov. 7, 1995
Hawkins	6,000,000	Dec. 7, 1999
		(effectively filed Oct. 13, 1995)

James Martin, "Principles of Object-Oriented Analysis and Design," (June 1, 1992).

Mark Gibbs, et al., "Absolute Beginner's Guide to Networking," (November 21, 1994)

### Rejections At Issue

Claims 58-67, 69, and 72-107 stand rejected under 35 U.S.C. § 102 as being anticipated by Gibbs, et al (referred to as **Network** in the brief, answer, and here after).

Claims 68 and 70 stand rejected under 35 U.S.C. § 103 as being obvious over Network in view of Hilt.

Claim 71 stands rejected under 35 U.S.C. § 103 as being obvious over Network in view of Hawkins.

Claims 108 and 109 stand rejected under 35 U.S.C. § 102 as being anticipated by Martin.

Claims 110 and 111 stand rejected under 35 U.S.C. § 103 as being obvious over Network in view of Martin.

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Throughout our opinion, we make reference to the Appellants' brief, and to the Examiner's Answer for the respective details thereof.

### **OPINION**

With full consideration being given to the subject matter on appeal, Examiner's rejections and the arguments of Appellants and Examiner, for the reasons stated *infra*, we reverse Examiner's rejection of claims 58-67, 69, and 72-107 under 35 U.S.C. § 102, we reverse Examiner's rejection of claims 68 and 70 under 35 U.S.C. § 103, we reverse Examiner's rejection of claim 69 under 35 U.S.C. § 103, we reverse Examiner's rejection of claims 108 and 109 under 35 U.S.C. § 102, and we reverse Examiner's rejection of claims 110 and 111 under 35 U.S.C. § 103.

#### **I. Whether the Rejection of Claims 58-67, and 69 Under 35 U.S.C. § 102 is proper?**

It is our view, after consideration of the record before us, that the disclosure of Network does not fully meet the invention as recited in claims 58-67 and 69. Accordingly, we reverse.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. See *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v.*

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**American Hoist & Derrick Co.**, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 58, the Examiner has indicated how he finds anticipation of the claims on appeal [answer, page 5]. The Examiner deems "Script to attach and log on" to meet the "mini app dialog component" and "transaction executor component." Appellants argue that the "Network does not disclose a system comprising two separate components: a mini-app dialog component and a transaction executor component" (brief, page 6, lines 7-9). Particularly, "instantiation" as required by claim 58 does not occur (brief, page 7, 14-19).

To determine whether claim 58 is anticipated, we must first determine the scope of the claim. Our reviewing court states in **In re Zletz**, 983 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow." Our reviewing court further states, "[T]he terms used in the claims bear a 'heavy presumption' that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art." **Texas Digital Systems Inc v. Telegenix Inc.**, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002).

Upon our review of Appellants' specification, we fail to find any definition of the term "instantiation" that is different

from the ordinary meaning. We find the ordinary meaning of the term "instantiation" is best found in the dictionary. We note that the definition most suitable for "instantiation" is "In object-oriented programming, to create an instance of a class."<sup>1</sup>

We find that the Network reference fails to teach either "mini applications" (applets) or "instantiation" of a transaction execution component. We note that "instantiation" is a function specific to object oriented programming and the Network reference is not directed to such programming. Therefore, Appellants' arguments are persuasive and we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

**II. Whether the Rejection of Claims 72-107 Under 35 U.S.C. § 102 is proper?**

It is our view, after consideration of the record before us, that the disclosure of Network does not fully meet the invention as recited in claims 72-107. Accordingly, we reverse.

With respect to independent claim 72, the Examiner has indicated how he finds anticipation of the claims on appeal [answer, page 7]. The Examiner deems "Presentation layer of OSI by definition" to meet the claimed "converting the first request for a service function from the first format into a canonical

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<sup>1</sup> Microsoft Press Computer Dictionary, 1991, page 189. Copy provided to Appellants.

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format" [answer, page 7, lines 16-17]. The Examiner also points to the glossary of Network, at page 439, to further teach that the presentation layer is the sixth layer of the OSI model and "is where the formatting and translation of data is performed so that the application layer can understand what's going on." Appellants argue, "the Examiner failed to point out where in Network it is shown that the various cited sections are combined to arrive at the claimed invention" (brief, page 11). With respect to the presentation layer, Appellants also argue, "it does not logically follow that the format of such data must be the canonical representation of the information." Appellants' arguments are persuasive. Also, we note that the claim requires that the receiving step of claim 72 is for "a first request for a service function from a first user through a first remote device" and the Examiner has not shown this element in the reference. The Examiner has failed to provide a prior art reference that discloses every element of the claim. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

With respect to independent claim 83, it is the apparatus for carrying out the process of claim 72. Claim 83, recites a system for "receiving a request for a service function from the user through the remote device" and "converting the request into a canonical format." These functions correspond to the functions

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of claim 72. The rejection of claim 83 is reversed for the same reasons as discussed above with respect to claim 72.

**III. Whether the Rejection of Claims 68 and 70 Under 35 U.S.C. § 103 is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 68 and 70.

With respect to claim 68, we note that the Examiner has relied on the admitted prior art solely to teach connecting a phone and ATM to a network [answer, page 15]. Hilt in combination with the Network reference fails to cure the deficiencies of Network noted above with respect to claim 58. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103(a) for the same reasons as set forth above.

**IV. Whether the Rejection of Claim 71 Under 35 U.S.C. § 103 is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claim 71.



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With respect to claim 71, we note that the Examiner has relied on the admitted prior art solely to teach attaching a PDA to a network [answer, page 16]. Hawkins in combination with the Network reference fails to cure the deficiencies of Network noted above with respect to claim 58. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103(a) for the same reasons as set forth above.

**V. Whether the Rejection of Claims 108 and 109 Under  
35 U.S.C. § 102 is proper?**

It is our view, after consideration of the record before us, that the disclosure of Martin does not fully meet the invention as recited in claims 108 and 109. Accordingly, we reverse.

With respect to independent claim 108, the Examiner has indicated how he finds anticipation of the claims on appeal [answer, page 16]. The Examiner deems that "With OO Techniques and rules we want the most direct translation of business policies into generated code" (Martin reference, page 136) meets the "a transaction executor component instantiated by the mini-app dialog component to perform the requested service function" limitation of claim 108 [answer, page 16, lines 11-14]. Appellants argue, the transaction executor component is not found in Martin (brief, page 18, lines 1-4). We find Appellants' argument to be persuasive as we are unable to determine how the

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transaction executor component details of claim 108 are met by page 136 of the Martin reference. The Examiner has failed to establish that Martin meets each and every limitation of the rejected claims. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

**VI. Whether the Rejection of Claims 110 and 111 Under  
35 U.S.C. § 103 is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 110 and 111.

With respect to independent claim 110, we note that claim 110 completely includes the subject matter and language of claim 72 and adds thereto a "rule broker" and the function thereof. We also note that the Examiner has relied on Martin solely to teach the rule broker and its function [answer, page 18]. Martin in combination with the Network reference fails to cure the deficiencies of Network noted above with respect to claim 72. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103(a) for the same reasons as set forth above.

With respect to independent claim 111, it is the apparatus for carrying out the process of claim 110. Claim 111, recites a

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system that "receives a request for a service function from the user through the remote device" and converting the request into a canonical format." These functions correspond to the functions of claim 110. The rejection of claim 111 is reversed for the same reasons as discussed above with respect to claim 110.

#### **Other Issues**

At the earliest appropriate point, the Examiner should address whether apparatus claim 58 and any other similar claims should be rejected under 35 U.S.C. § 102 or § 103 over Gish 6,052,711 and Cowan et al 5,828,840. These two patents and other related patents assigned to Sun Microsystems and Verifone, Inc., teach mini-app (applet) based client server network systems. The Verifone patents specifically teach such systems for business applications.

Similarly, the Examiner should address whether apparatus claim 72 and any other similar claims should be rejected under 35 U.S.C. § 102 or § 103 over Lam et al 5,926,636 and any other appropriate references. Lam et al teaches a function called format translation at col. 3, lines 62-67, and col. 12, lines 37-44.

Further, the Examiner should address whether claims 72-107, 110, and 111 are supported by the specification as originally filed and whether a rejection under 35 U.S.C. § 112, first

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paragraph is appropriate. See the Manual of Patent Examining Procedure § 2163.01. Appellants' specification as filed discusses the "canonical format conversion" in only a few places and all of those save one are directed to data output from a host to a remote device. At only one location does the specification discuss receiving messages in the reverse direction from a remote device to a host (See Appellants' specification page 12, lines 12-16). Claim 72 is specifically directed to requests from a remote device to a host. This very limited originally filed disclosure of receiving messages from a remote device at a host does not support the current claim language, which recites detailed functions and other limitations not found in the few lines on page 12 of Appellants' specification.

Lastly, given the parent application resulted in very similar claims; the Examiner should address the issue of obviousness double patenting.

#### **Conclusion**

In summary, we have not sustained any of the Examiner's rejections of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 58-111 is reversed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**REVERSED**

Thank You

MICHAEL R. FLEMING  
Administrative Patent Judge

Joseph H. Ruggiero

JOSEPH F. RUGGIERO  
Administrative Patent Judge

ALLEN R. MACDONALD  
Administrative Patent Judge

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